**REMARKS-General**

The Applicant is in receipt of the final Office Action (O.A) dated October 21, 2004. In the O.A. the Examiner now rejects claims 1-22 under 35 USC 103(a) as unpatentable over McDonald (USPN 6,069,848), in combination with Nowlan (claims 1-8, 12, 14-16, 18, 19, 21, and 22), Nowlan and Kendrick (claim 13), or Nowlan and Slotznick (claims 9-11, 17, and 20).

The Applicant notes that the current rejection is a direct contradiction to the previous O.A. of April 7, 2004, in which these claims were merely objected to, and the interview of July 6, 2004, in which these revised claims were discussed and the Examiner indicated that the claims would be allowable as amended. Based on this information, the Applicant filed the current RCE containing these revised claims. As documented in the Examiner's interview summary (PTOL-413, mailed July 9, 2004) and the Applicant's interview summary of August 9, 2004, agreement was reached at the interview that the claims would be allowable if amended as discussed at the interview. As a *pro se* inventor, the Applicant has repeatedly demonstrated the invention to the Examiner and has actively sought the advice of the Examiner in placing the application in a condition for allowance, leading now to the filing of a second RCE. Despite this history of discussion and agreement the current Office Action now introduces new prior art that adds nothing to the previously discussed prior art, and is irrelevant to a determination of patentability for reasons previously discussed (and agreed upon with the Examiner) in connection with previously cited prior art.

*Summary of the cited prior art.*

McDonald (USPN 6,069,848) provides a mechanical device (akin to a stopwatch) that measures elapsed time starting at one or more events. McDonald provides an example in which this elapsed time is provided in days, such that this device may be used to measure the life of an individual in days.

Nowlan (non-patent literature "Born This Day. . ." provides a listing of prominent individuals and their birthdays.

Kendrick (USPN 5,031,161) provides a life expectancy timepiece, which reports an individual's life expectancy based on that individual's current age and other information, at any given time.

Slotznick (USPN 5,983,200) provides an electronic greeting card.

The current invention provides a person with customized information regarding what other individuals accomplished when those other individuals were the same age as the person. Specifically, claim 1 provides:

> 1. A computer-implemented method for providing a user with age-event information comprising:
> a) receiving an input signal;
> b) determining age information from said input signal; and
> c) providing an output signal comprising age-event information corresponding to said age information;
> wherein said age information comprises the age of a first individual on a specific date and said age-event information comprises information regarding an event that occurred in the life of a second individual when said second individual was at an age equal to the age of said first individual on said specific date.

The current rejection appears to be based upon a definition of age-event information that is inconsistent with the specification and the claims. Claim 1 clearly

defines age-event information as comprising ". . . information regarding an event that occurred in the life of a second individual when said second individual was at an age equal to the age of said first individual on said specific date." It appears that the current rejection is based primarily on the logic of combining McDonald, which does not provide age-event information as defined in the specification or the claims, but which the Examiner interprets to contain age-event information by some other definition that is not made explicit in the O.A., with Nowlan, which the Examiner interprets as providing a definition for age-event information, although Nowlan actually contains no such definition consistent either with the specification or the claims. If, on the final Office Action, the Examiner continues to maintain that McDonald teaches the "age-event information" called for by claim 1, the Applicant respectfully requests that the Examiner cite some authority for disregarding the plain language in claim 1 that provides a clear definition of this term.

**1. McDonald does not provide age-event information, as asserted in the O.A.**

According to the O.A., McDonald (column 7, lines 59-65) "provides an output signal comprising age-event information corresponding to said age information." (O.A. page 3). The Applicant respectfully disagrees with this assertion. The cited lines from McDonald are reproduced here:

> Display formats can be selected by the user under the Settings function. The elapsed time (or time remaining) can be displayed on display 18 in different units of times. For example, in FIG. 1, display 18 is shown displaying the elapsed time from the birth of Kelly Tigh McDonald, in units of seconds, and simultaneously, in units of minutes, hours, days, weeks, months, and years. In another display format, the different units of time can be displayed separately (i.e., one-at-a-time) by scrolling with cursor keys 56 and 58.

These lines indicate that the clock of McDonald may be used to show the age of Kelly Tigh McDonald in various units at a given time. This, however, is completely unrelated to age-event information, which is defined in claim 1 as:

> said age-event information comprises information regarding an event that occurred in the life of a second individual when said second individual was at an age equal to the age of said first individual on said specific date.

The O.A. does not explain how the age of an individual in various units is construed to comprise information regarding an event that occurred in the life of a second individual when said second individual was at an age equal to the age of said first individual on said specific date. In fact, these are two completely different things; thus, McDonald does not "provide age-event information corresponding to said age information."

**2. Nowlan does not teach "an event in the life of a second individual when said second individual was at an age equal to the age of said first individual," as asserted in the O.A. (O.A. page 3).**

To support this statement, the O.A. cites the following entry under George Foreman, in the cited book.

> 1949 **George Foreman**: U.S. boxer. World heavyweight champ (1973-74). Lost title to Muhammad Ali. Regained it at 46 in 1994. Oldest champion of all time.

While Nowlan teaches an event that occurred in the life of George Foreman in 1994 at age 46 (i.e., regaining the heavyweight boxing title), Nowlan does not relate this to the age of a specific first individual, as would be required for the O.A.'s assertion that Nowlan teaches "an event in the life of a second individual when said second individual was at an age equal to the age of said first individual" to be true.

**3. Neither McDonald nor Nowlan meets other requirements of claim 1, and thus, the combination of these references does not arrive at the invention of claim 1.**

Neither McDonald nor Nowlan provides a computer implemented method to provide an output signal comprising age-event information corresponding to said age information. Both age information and age-event information are clearly defined as a part of the claim. Moreover, neither McDonald nor Nowlan involves a comparison between two individuals. Thus, the combination of these references does not arrive at the invention of claim 1.

**4. While the combination of McDonald and Nowlan does not arrive at the claimed invention, even if combinations of McDonald and Nowlan arrived at the present invention, it would be inappropriate to consider these combinations in an obviousness determination.**

***a) McDonald and Nowlan Do Not Contain Any Justification or Motivation to Support Their Combination to Arrive at the Present Invention.***

With regard to the proposed combination of McDonald and Nowlan, it is well known that in order for any prior art references themselves to be validly combined for use in a prior art section 103 rejection, *the references themselves* (or some other prior art) must suggest that they be combined. E.g., as was stated in In re Semaker, 217 USPQ 1, 6 (Fed. Cir. 1983):

> "[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings."

That the suggestion to combine the references should not come from applicant was forcefully stated in Orthopedic Equipment Co. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983):

> "It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law [here the PTO]."

As was further stated in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 USPQ2d 1434 (Fed. Cir. 1988):

> "Where prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself. . . . *Something in the prior art must suggest the desirability and thus the obviousness of making the combination.*" [Emphasis applied.]

In line with these decisions, the Board stated in Ex parte Levengood, 28 USPQ2d 1300 (BPAI 1993):

> "In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive, or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. . . . That which is within the capabilities of one skilled in the art is not synonymous with obviousness. . . . That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention. . . . Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that 'would lead' that individual 'to combine the relevant teachings of the references.' . . . Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done."

The O.A. supports the proposed combination of McDonald and Nowlan with the statement, "The motivation to combine Nowlan and McDonald is that the system creates and (sic) interesting concepts to learn which prominent people in history and in the news today share ones birthday, and to read some of the wit or wisdom of such individuals" (O.A., p. 4). While this "motivation" is derived from the preface of Nowlan, this simply cannot be construed as a motivation to combine Nowlan with McDonald. This provides no motivation for combinations with other inventions, and in fact, teaches against

combinations that involve comparison of ages, by explicitly stating that one purpose of Nowlan is to identify individuals with shared birthdays. Moreover, Nowlan does not contemplate the creation of an interactive system, but instead refers simply to the publishing of a book.

As stated in the above Levengood case:

> "That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention."

Applicant therefore submits that combining McDonald and Nowlan is not legally justified and is therefore improper. Thus, Applicant submits that the rejection on these references is also improper and should be withdrawn. Applicant respectfully requests, that if the claims continue to be rejected on any combination of references, that the Examiner include an explanation, in accordance with MPEP 706.02, Ex parte Clapp, 27 USPQ 972 (BPAI 1985), and Ex parte Levengood, *supra*, of a "factual basis to support his conclusion that it would have been obvious" to make the combination.

***b) McDonald and Nowlan are individually complete, and solve different problems from the present invention.***

Because McDonald and Nowlan each describe complete inventions (McDonald related to a glorified stopwatch, and Nowlan is a book that provides biographical data), each reference further lacks motivation for any combinations with other inventions. Each

reference is complete and functional in itself, so there would be no reason to use parts from, or add or substitute parts to, any reference.

Moreover, applicant's invention solves a different problem than the references, and such different problem is recited in the claims (In re Wright, 6 USPQ2d 1959 (1988)). In particular, the present invention provides "a user with age-event information corresponding to . . . age information" (Claim 1), a problem clearly not addressed by any of the cited prior art.

***c) The present invention yields advantages not appreciated by McDonald or Nowlan.***

Among others, the present invention provides the advantage over Nowlan that each individual may be related (via similar ages at different times) to any other individual, thus permitting interesting comparisons with all historical figures, rather than limiting those comparisons to individuals who share one's birthday. McDonald provides only time information, and provides no further information of interest to those who would like to compare one's life with that of a historical figure. Thus, these clear advantages are not provided either by McDonald nor Nowlan separately, and nothing in either McDonald or Nowlan suggests that the advantages of the current invention may be obtained through any combination of inventions involving either of these references.

***d) Nobody has attempted to combine McDonald and Nowlan in the manner suggested by the O.A.***

Although combination of McDonald and Nowlan does not arrive at the claimed invention, Applicant is unaware of any existing combination of these references to arrive at any invention. Moreover, if the present invention were in fact obvious due to these or any combination of prior art references, because of its advantages, those skilled in the art surely would have implemented it by now. That is—the fact that those skilled in the art have not implemented the invention, despite its great advantages, indicates that it is not obvious.

**5. Discussion of individual claim rejections.**

In rejecting claims 2, 15, and 22 (O.A., page 4), the O.A. relies upon a discussion of celebrity ageliners. The Applicant respectfully points out that claim 22 does not refer to celebrity ageliners, and the O.A.'s reasons for rejecting claim 22 are unrelated to the actual claim.

According to the O.A. (page 5),

> Nowlan teaches the output signal comprises a celebrity ageliner, wherein said celebrity ageliner names a celebrity and describes a historical event in the life of an individual that occurred when said individual was the age of said celebrity on said date.

First, it is clear that Nowlan does not teach an output signal. Second, the O.A.'s example does not meet the specified limitations. According to the O.A., the celebrity is George Foreman. If that is the case, who is the individual in whose life the historical event occurred? According to the O.A.'s rejection of claim 1, George Foreman is the historical individual. However, since claims 2 and 14 are dependent on claim 1, it is clear that the

celebrity and the historical individual must be different people (there is a requirement for a first individual and a second individual). Thus, the O.A. does not explain how these references may be used to generate a celebrity ageliner that meets the limitations of the claim. In this same claim rejection, the O.A. cites the motivation that:

> The motivation to combine Nowlan and McDonald is that the system creates and (sic) interesting concepts to learn which prominent people in history and in the news today share ones birthday, and to read some of the wit or wisdom of such individuals.

However, it is clear from the claims that a celebrity ageliner has nothing to do with "one's birthday", but has to do instead with comparing the age of celebrities with the age of historical figures. Thus, this motivation is completely irrelevant to the creation of celebrity agcliners.

The rejection of claims 8, 16, and 19 are based upon the ability of the clock in McDonald to provide a greeting, "Happy Anniversary." However, this greeting does not comprise age-event information, which according to the claims must comprise "information regarding an event that occurred in the life of a second individual when said second individual was at an age equal to the age of said first individual on said specific date." The O.A. does not explain how the statement "Happy Anniversary" meets this limitation, which, of course, it does not.

The rejection of claim 12 is based upon the ability of the clock in McDonald to provide the name of an individual, his birthdate, and elapsed time since birth. However, these data do not comprise age-event information, which according to the claims must comprise "information regarding an event that occurred in the life of a second individual when said second individual was at an age equal to the age of said first individual on said

specific date." The O.A. does not explain how an individual's name, date of birth and age meet this limitation, which, of course, they do not.

In the rejection of claim 21, the O.A. claims that "Nowlan teaches receiving an input signal comprising the name of a second individual (see page 9, "1949 George Foreman")." This statement is patently false, as Nowlan does not teach the receipt in a computer system of any signal.

In the rejection of claim 22 on page 9, the Examiner evidently cut and pasted a paragraph from the April, 2004 Office Action, that has no relevance to the current claims or to the prior art under discussion. The Examiner has already agreed that the invention is patentable over this prior art.

In the rejection of claim 13, the O.A. cites Kendrick as teaching the steps of generating a life-clock display for said first individual . . .; and providing age-event information on said life-clock (see fig. 2.) (O.A. page 10). Figure 2 of Kendrick provides a stopwatch that shows expected time remaining in life. However, this does not comprise age-event information, which according to the claims must comprise "information regarding an event that occurred in the life of a second individual when said second individual was at an age equal to the age of said first individual on said specific date." The O.A. does not explain how a display of expected remaining lifespan meets this limitation, which, of course, it does not. In addition, the O.A. cites inappropriate motivation for combining Kendrick with McDonald and Nowlan. While Kendrick provides a timepiece for estimating the lifespan of a user, which is settable by programming given events in the user's life, this provides no motivation for comparing the lives of two different individuals.

The rejections of claims 2-22 are also improper for the same reasons that the rejection of claim 1 is improper.

**Conclusion**

For all of the above reasons, the specification and all claims are in proper form, and the claims all define patentably over the prior art. Therefore, this application is still in condition for allowance, which action is respectfully solicited.

Very Respectfully,

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Date: 21 Jan 2005

Inventor's Signature